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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,919	12/01/2000	Yukihiko Aoki	450100-02892	6325
20999	7590	11/03/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			ONUAKU, CHRISTOPHER O	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/727,919	Applicant(s) AOKI ET AL.	
	Examiner Christopher O. Onuaku	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/9/04 has been entered.

Response to Arguments

2. Applicant's arguments filed 9/6/04 with respect to claims 1,11,12,18,43,47&53 have been fully considered but they are not persuasive.

Applicant argues that Okuyama fails to disclose that the first and second image frames are either intra-frames or predictive picture frames, and that Okuyama further fails to disclose adding position information data to the second image frame, wherein the information data includes the address of the first image frame, and is recorded together with the second image frame onto the recording medium

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3&5-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Okuyama (US 6,289,169).

Regarding claim 1, Okuyama discloses an apparatus for and a method of displaying recorded contents preferred to program guide information on digital broadcast, comprising:

a) first extraction means for extracting content information of the program (see Fig.1; demultiplexer 12 and the transport stream; col.6, lines 18-25; and col.7, lines 14-19 and “the Olympic games highlights” as the transport stream);

b) second extraction means for extracting relevant information of the program (see Fig.1; demultiplexer 12 and the SIT stream; col.6, lines 18-25; and col.7, lines 14-19);

c) first output means (see Fig.1 and I/F circuit 13 of STB 1) for outputting the content information extracted by the first extraction means to the other information processing apparatus (see Fig.1 and VTR 3) via the network (see Fig.1 and cable 5

which is IEEE-1394 network) so that the content information is recorded in a first recording medium (see recording medium of the recording/reproducing unit 32) of the other information processing apparatus (see col.7, lines 19-30);

d) conversion means for converting the relevant information extracted by the second extraction means into a format in which the information can be processed by the other information processing apparatus (see Fig.1, I/F circuit 13 which converts the inputted stream into an isochronous packet and transmits it to cable 5; col.6, lines 25-30; and col.7, lines 14-19; the EIT data is "converted" to the IEEE-1394 format for delivery to cassette memory 33);

e) second output means (see Fig.1 and I/F circuit 31) for outputting the relevant information (GUI, which is part of SIT) whose format is converted by the conversion means to the other information processing apparatus via the network (cable 5 of Fig.1) so that the relevant information whose format is converted by the conversion means is recorded in a second recording medium (see Fig.1 and memory unit 33 of VTR 3) of the other information processing apparatus (see Fig.1, I/F circuit 31; col.7, lines 14-41).

Regarding claim 2, Okuyama discloses wherein the network comprises an IEEE 1394 serial bus (see Fig.1, cable 5; col.4, lines 20-25 and col.6, lines 25-37).

Regarding claim 3, Okuyama discloses wherein the first recording medium is a video cassette (see Fig.1; VTR 3 and cassette tape in VTR 3; col.7, lines 19-30).

Regarding claim 5, Okuyama discloses wherein the relevant information contains at least one of the title, provider information, provider name, a genre code, the recorded position in the first recording medium, the recording start date and time, and the number of updates (see col.6, lines 1-4).

Regarding claim 6, the claimed limitations of claim 6 are accommodated in the discussions of claim 1 above.

Regarding claim 7, the claimed limitations of claim 7 are accommodated in the discussions of claim 1 above, including computer-readable recording medium (see Fig.8, PC 63; col.11, lines 60-67).

Regarding claim 8, Okuyama discloses an apparatus for and a method of displaying recorded contents preferred to program guide information on digital broadcast, comprising:

a) reading means for reading relevant information (see SIT stream) recorded in the second recording medium (see Fig.1, and cassette memory unit 33 of the VTR 3) of the other information processing apparatus (see Fig.1, VTR 3) via the network (see Fig.1, cable 5) (see Fig.1; demultiplexer 12 and the SIT stream; col.6, lines 18-25; and col.7, lines 14-19);

b) conversion means for converting the relevant information read by the reading means into a format in which the information can be processed by the other information

processing apparatus (see Fig.1, I/F circuit 13 which converts the inputted stream into an isochronous packet and transmits it to cable 5; col.6, lines 25-30; and col.7, lines 14-19);

c) display control means for controlling the display of the relevant information whose format is converted by the conversion means (see Fig.1, controller 26, program guide GUI generating part 25 for generating GUI data; col.6, lines 38-55);

d) selection means for selecting a desired program on the basis of the relevant information whose display is controlled by the display control means (see Fig.1; controller 26 and the controller acting on the program selected by the user using a remote controller, for example, and STB 1; col.7, lines 9-14 and col.8, lines 8-18); and

e) playback means for controlling the other information processing apparatus via the network and for playing back the content information of the program selected by the selection means from the first recording medium (see Fig.1, VTR 3 which includes the recording/reproducing unit 32; col.8, lines 1-35).

Regarding claim 9, Okuyama discloses processing apparatus further comprising:

a) storage means for storing the relevant information which is converted by the conversion means (see Fig.1; cassette memory 33 of VTR 3; col.5, lines 62-65); and

b) updating means for comparing the relevant information read by the reading means, and for updating the relevant information stored in the storage means to the relevant information read by the reading means (see col.10, lines 44-51).

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Regarding claim 10, the claimed limitations of claim 10 are accommodated in the discussions of claim 2 above.

Regarding claim 11, the claimed limitations of claim 11 are accommodated in the discussions of claim 3 above.

Regarding claim 12, the claimed limitations of claim 12 are accommodated in the discussions of claim 4 above.

Regarding claim 13, the claimed limitations of claim 13 are accommodated in the discussions of claim 5 above.

Regarding claim 14, the claimed limitations of claim 14 are accommodated in the discussions of claim 8 above.

Regarding claim 15, the claimed limitations of claim 15 are accommodated in the discussions of claims 7&8 above.

Regarding claim 16, Okuyama discloses an apparatus for and a method of displaying recorded contents preferred to program guide information on digital broadcast, comprising:

a) first acquiring means for acquiring a first instruction from the other information processing apparatus via the network (see col.5, lines 38-41 and col.6, line 55 to col.7, line 14-65);

b) first recording means for recording content information of the program supplied from the other information processing apparatus via the network into a first recording medium on the basis of the first instruction acquired by the acquiring means (see Fig.1, VTR 3; col.5, lines 38-47 and col.7, lines 19-30);

c) second acquiring means for acquiring a second instruction from the other information processing apparatus via the network (see col.5, lines 54-60 and col.7, line 66 to col.7, line 9); and

d) second recording means for recording relevant information of the program into a second recording medium which is attached to the first recording medium on the basis of the second instruction acquired by the second acquiring means (see Fig.1, cassette memory unit 33 of VTR 3; col.5, lines 61-65 and col.7, lines 31-40) .

Regarding claim 17, the claimed limitations of claim 17 are accommodated in the discussions of claim 2 above.

Regarding claim 18, the claimed limitations of claim 18 are accommodated in the discussions of claim 3 above.

Regarding claim 19, the claimed limitations of claim 19 are accommodated in the discussions of claim 4 above.

Regarding claim 20, the claimed limitations of claim 20 are accommodated in the discussions of claim 5 above.

Regarding claim 21, the claimed limitations of claim 21 are accommodated in the discussions of claim 16 above.

Regarding claim 22, the claimed limitations of claim 22 are accommodated in the discussions of claims 15&21 above.

Regarding claim 23, Okuyama discloses an apparatus for and a method of displaying recorded contents preferred to program guide information on digital broadcast, comprising:

a) first acquiring means for acquiring a first instruction from the other information processing apparatus via the network (see Fig.1, controller 26; col.5, lines 38-41 and col.6, line 55 to col.7, line 14);

b) reading means for reading relevant information (see SIT stream) recorded in the second recording medium (see Fig.1, and cassette memory unit 33 of the VTR 3) of the other information processing apparatus (see Fig.1, VTR 3) via the network (see

Fig.1, cable 5) (see Fig.1; controller 26; SIT stream which contains EIT and EPG/GUI data; col.8, lines 1-31);

c) second acquiring means for acquiring information about content information of the program selected by the other information processing apparatus on the basis of the relevant information read by the reading means; (see Fig.1, VTR 3) via the network (see Fig.1, cable 5) (see Fig.1; controller 26; SIT stream which contains EIT and EPG/GUI data); col.8, lines 1-31), here examiner reads "acquiring information about content information" as reading relevant information about the content information which controller 13 does, as shown in 23(b) above and user using a remote controller selects a program, the relevant information of which the controller reads in order, later, to reproduce the selected content information; and

e) playback means for playing back the content information from the first recording medium on the basis of information about the content information acquired by the second acquiring means (see Fig.1; recording/reproducing unit 32; col.8, lines 1-31).

Regarding claim 24, the claimed limitations of claim 24 are accommodated in the discussions of claim 2 above.

Regarding claim 25, the claimed limitations of claim 25 are accommodated in the discussions of claim 3 above.

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Regarding claim 26, the claimed limitations of claim 26 are accommodated in the discussions of claim 4 above.

Regarding claim 27, the claimed limitations of claim 27 are accommodated in the discussions of claim 5 above.

Regarding claim 28, the claimed limitations of claim 28 are accommodated in the discussions of claim 23 above.

Regarding claim 29, the claimed limitations of claim 29 are accommodated in the discussions of claims 7&28 above.

DETAILED ACTION

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okuyama.

Regarding claim 4, Okuyama discloses cassette memory unit 33 (second recording medium) attached to the VTR 3. The cassette memory unit 33 is designed to

read information written in a cassette memory mounted in a tape cassette and also able to write information from the recording/reproducing unit 32 in a cassette memory unit 33 (see Fig.1, MIC cassette memory 33 which is attached to a VTR 3; col.2, lines 43-52; col.5, lines 47-65 and col.12, lines 40-60). Okuyama fails to explicitly disclose wherein the second recording medium is an IC card. Official Notice is taken that it is well known in the art to employ IC cards for storing data, and it is also well known in the art that an IC card is a detachable memory device. Therefore, it would have been obvious to one of ordinary skill in the art to embody memory unit 33 as an IC card in order to provide a detachable memory unit.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matsumi et al (US 6,711,343) teach a data recording/reproducing apparatus for recording/reproducing digital stream data, including video and audio stream data, as files.

Candelore (US 6,363,149 teaches a method and apparatus for scrambling program data such that the program data may be de-scrambled for viewing at a future time without experiencing the problems associated with key expiration.

Boetje et al (US 6,038,368) teach an apparatus, a computer system, and a method for recording, editing, reviewing, and distributing video segments. Any inquiry concerning this communication or earlier communications from the examiner should be

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directed to Christopher O. Onuaku whose telephone number is (703) 308-7555. The examiner can normally be reached on M-F 8:30-6:00.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


COO

10/26/04


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